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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,493	09/26/2003	Thomas Berger	1685-3	3531
81099	7590	12/08/2008	EXAMINER	
Thomas M. Galgano 20 W. Park Avenue Suite 204 Long Beach, NY 11561			CUMARASEGARAN, VERN	
			ART UNIT	PAPER NUMBER
			3629	
			MAIL DATE	DELIVERY MODE
			12/08/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/672,493

Applicant(s)

BERGER, THOMAS

Examiner

VERN CUMARASEGARAN

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald (US 7,054,833 B1).

As to claim 1, McDonald shows interrogating a data file of property owner addresses (col.12 lines 32-35); comparing the addresses to database addresses certified to be in existence (col.9 lines 1-4 where the specific type of database is considered non-functional descriptive language since it does not functional affected the recited steps). McDonald does not expressly show assigning a probable escheat jurisdiction based on the comparison. However, McDonald does show determining the address of the previous owner and contacting the owner at the last known address. Examiner takes official notice that it is old and well known in the art to assign a probable escheat jurisdiction based on the last known address of the property owner (Texas v. New Jersey [379 U.S. 674 (1965)]). It would have been obvious to one of ordinary skill in the art to incorporate the method of assigning probable escheat jurisdiction based on the comparison since the claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it

did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As to claims 2-6, **examiner takes official notice** that it is old and well known in the art to determine an error range or confidence code for calculations and editing information such as addresses based on comparison. For example, when conducting a population census that takes into account the residences of the population, an error range is always calculated.

As to claims 7-18, **examiner takes official notice** that it is old and well known in the art to use comparison methods in determining escheat jurisdiction. For example, the current location of the property is compared with the last known location of the owner when determining escheat jurisdiction. It would have been obvious to one of ordinary skill in the art to use the various comparison editing methods in determining the escheat jurisdiction since the claimed invention is merely a combination of old known elements.

As to claim 19, McDonald shows generating a report (col.9 lines 50-60).

As to claim 20, McDonald shows using computer coupled to the internet (Fig.1).

Response to Arguments

Applicant's arguments filed August 8, 2008 have been fully considered but they are not persuasive.

Applicant's first argument that McDonald shows searching a name to retrieve an address where as the invention begins with an address and searches a database is

irrelevant. The claim as recited does not expressly show beginning with an address to be searched. Rather, the claim recites "interrogating a data base of property owner addresses" which is interpreted to be searching a database as shown by McDonald (col.12 lines 32-35).

As to the applicant's second argument that McDonald does not teach comparing an address to a US Postal Service certified database is not valid. McDonald shows using an address database which would be used to verify the accuracy of addresses (col.9 lines 12-15). Moreover, the specific type of database used is considered non-functional descriptive language and thus is not given patentable weight. The recited method steps would be performed the same regardless of the specific type of database used in the comparing step. Thus, when the prior art describes all of the claimed structural and functional relationships between descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the claimed descriptive material is non-functional and will not constitute a sufficient difference from the prior art to establish patentability. The USPTO need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004).

In response to applicant's third argument that McDonald does not teach determining the correct escheat state, is not given patentable weight since it is considered intended use of the method. The method being adapted to determine the correct escheat state is irrelevant since the intended use does not change the overall

functionality of the method. The intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As to claims 2-6 and 7-18, the use of official notice is maintained because the applicant did not properly traverse the official notice. The applicant did not specifically point out the supposed errors in the official notice such as stating why the noticed fact is not considered to be common knowledge as required by MPEP 2144.03(C). The common knowledge statements are taken to be admitted prior art because the applicant did not adequately traverse the assertion of official notice.

As to claim 19, the specific content of the report is considered non-functional descriptive language and thus is not given patentable weight.

Conclusion

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERN CUMARASEGARAN whose telephone number is (571)270-3273. The examiner can normally be reached on Monday - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. C./
Examiner, Art Unit 3629

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629

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